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Once a claim that is determined to be generic is allowed, all of the claims drawn to species in addition to the elected species which include all the limitations of the generic claim will ordinarily be obviously allowable in view of the allowance of the generic claim, since the additional species will depend thereon or otherwise include all of the limitations thereof.

MPEP, Section 806.04(d). Moreover, MPEP, Section 809(c)(B)(1) also states:

When all claims to each of the additional species are embraced by an allowable generic claim as provided by 37 CFR 1.141, applicant must be advised of the allowable generic claim and that claims drawn to the nonelected species are no longer withdrawn since they are fully embrace by the allowed generic claim.

Therefore, pursuant to MPEP Sections 806.04(d) and 809.02(c)(B)(1), rejoinder of claims 26, 39, 45 and 53 is required because the generic claims have been deemed allowable by the Examiner.

Referring now to claims 55-59, the Examiner asserts in the Advisory Action dated October 4, 2001, and further during the phone interview of December 11, 2001, that original claims 4-7 "were non-elected by applicant in paper no. 6," i.e. Applicants' Election filed on August 25, 2000. However, the Examiner subsequently withdrew her species election requirement in the next Office Action dated November 14, 2000 (paper no. 7). Therefore, the Applicants' "non-election" of claims 4-7, which occurred before her withdrawal of the

species election requirement, is without question moot at this stage of the proceedings. Specifically, the Examiner cannot legally impose a species election requirement, then withdraw and then argue that her species election still is viable.

Moreover, during the phone interview of December 11, 2001, the Examiner pointed out that, for example, with respect to claims 55-59, they require the battery mounting device to be disposed on an "auxiliary table," where in fact original claims 4-7 require the battery mounting device to be disposed on a "base." For the Examiner's convenience, original claims 4-7 are reiterated herein:

Claim 4. A table saw as defined in claim 1 further including a base for supporting said table, said **battery mounting device being mounted on said base.** (Emphasis added).

Claim 5. A table saw as defined in claim 4, wherein said table is rotatably supported on said base and has a pair of auxiliary tables positioned on both sides of said table in opposed relationship with each other substantially in the diametrical direction of said table, wherein said **battery mounting device is mounted on one of said auxiliary tables.** (Emphasis added).

Claim 6. A table saw as defined in claim 5, wherein said table can rotate in opposite directions from a reference position within a predetermined angle, said motor is positioned on one side of said saw unit closer to one of said auxiliary tables when said table is in said reference position, and **said battery mounting device is disposed on the other of said auxiliary tables**, so that the battery mounted on said battery mounting device can serve as a counterweight to the moment of said motor. (Emphasis added).

Claim 7. A table saw as defined in claim 6, wherein said saw unit is mounted on a peripheral part of said table, so that said saw unit is positioned on one side in forward and rearward directions that is substantially perpendicular to the diameter of said table across said auxiliary tables when said table is in said reference position, **said battery mounting device on the other of said auxiliary tables** is positioned on the other side of said forward and rearward directions, so that the battery mounted on said battery mounting device can serve as a counterweight to the moment of said saw unit. (Emphasis added).

As is evident from the highlighted portions of claims 4 and 5, although claim 4 does in fact indicate that the battery

mounting device is mounted on the base, claim 5, which depends from claim 4, indicates that the battery mounting device is clearly mounted "on one of said auxiliary tables."

Furthermore, claims 6 and 7 also refer to the battery mounting device being mounted on the auxiliary tables. Therefore, each of original claims 5-7 refer to the battery mounting device being mounted on the auxiliary table, which is substantially similar to the present claim 55.

Moreover, originally presented claims 1 and 4 are generic to claims 55-59 and the Examiner previously fully examined claims 1 and 4-7 in the first Office Action without entering a species election requirement. In fact, claims 55-59 merely define claimed inventions that clearly fall within the scope of original presented, generic claims 1 and 4. Therefore, claims 55-59 can not be directed to a "different" invention, but rather a clarification of the previously presented claims.

Furthermore, it is respectfully submitted that the Examiner has not satisfied the requirements of a proper restriction requirement for restriction between patentably distinct inventions. Specifically, MPEP 803 states: "If the search and examination of an entire application can be made without serious burden, the examiner MUST examine it on the merits, even though it includes claims to independent or distinct inventions." (Emphasis added) Further, the Examiner

has failed to establish a serious burden to examine claims 55-59 in this application, which is one of the two criteria for a proper restriction between patentably distinct inventions.

Id. For example, the Examiner has failed to show by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined by MPEP 808.02. Id. (See also, MPEP 811 "Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required." (Emphasis added))

If the Examiner elects to maintain the restriction of claims 55-59, Applicants hereby request the Examiner according to MPEP 821.01 to respond to Applicants' arguments and specifically identify the serious burden imposed upon the Examiner to examine claims 55-59 in this application in order to properly frame the issues for further reconsideration of this restriction requirement.

Lastly, with respect to the Interview Summary dated December 11, 2001, Applicants would like to point out that, to make the record clear, NO Amendments were made to overcome the Examiner's Section 103 rejections. Rather, Applicants filed a certified translation of the Japanese priority document in order to overcome this rejection. This assertion is also

clear from the Examiner's Advisory Action dated October 4, 2001, first and second paragraphs. Wherefore, reconsideration and allowance of these claims is earnestly solicited.

Respectfully submitted,
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I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office (Fax No. (703) 872-9303) on December 12, 2001.

By: 

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